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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/689,610
Filing Date: October 22, 2003
Appellant(s): THEILER, DAVID

Thomas J. D'Amico, Reg. 28,371
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 January 2008 appealing from the Office

action mailed 31 August 2007.

(1) Real Part of Interest

A statement identifying by name the real part of interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after non-final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Miller et al. (U.S. 7,035,809)

User's Guide to Microsoft Project

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims: The

ground(s) for rejection are reproduced below from the Non-final Office Action, mailed 31

August 2007, and are provided here for the convenience of both the Appellant and the

Board of Patent Appeals:

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Miller et al. (U.S. 7,035,809) and User's Guide to Microsoft Project, 1995

(hereinafter, MSProject).

        As per claims 1 and 12, Miller et al. discloses a method and apparatus for

creating a workflow process management application suitable for an organization,

comprising:

        (a) creating on a computer system, a plurality of department objects; (b) creating,

on said computer system, a plurality of resource objects, each resource object being

associated with at least one of said department objects and a production resource of

said organization; (c) creating, on said computer system, a plurality of activity objects,

each activity object being associated with at least one of said department objects and

an activity of said organization; and (d) after steps (a), (b), and (c), and responsive to a

command, automatically generating, by said computer system, said workflow process

management application from said department objects, resource objects, and activity

objects (col. 5, lines 6-19; col. 6, lines 52-65; col. 20, lines 24-28; col. 27, lines 28-40;

col. 59, lines 34-53; Figure 11A; A user creates resources and tasks (i.e., activities) for

a defined organization through templates. Upon receipt of the resource, task and

organizational structure input, the system then automatically produces a plan for the

organization. An organization may be a department as the disclosure of the instant

application defines a department as an entity that exists to perform a set of core

functions.);

        wherein said workflow process management application, when executed by said

computer, permits a user to enter, for each department, a workflow plan for said

department, generate worker assignments, receive a workflow performed by

departments of said organization, create reports comparing said workflow plan with said

workflow performed (col. 7, lines 56-62; col. 8, lines 29-47; Various status reports for

project plans are generated, where the reports provide a measure of planned work

versus actual work performed for the organization involved with the project. Work

assignments may be created and changed.);

   said workflow process management application using said report to generate

subsequent worker assignments (col. 6, lines 16-21 and 44-65; col. 7, lines 59-67; col.

8, lines 39-53; Based on the content of the status reports, worker/task assignments may

be generated and reassigned or updated so as to rectify any discrepancies or identified

risks as a result of the comparison of the planned versus actual work performed.);

   wherein said workflow plan comprises a plurality of standards, each one of said

standards inter-relating at least one activity object with at least one resource object as a

function of time and skill (col. 6, lines 38-59; col. 24, lines 35-45; The project plan

identifies the human resources needed based on the project requirements (i.e.,

standards), where the human resources must be suitable for the task by having the

required skills and time availability.).

   Miller et al. does not expressly disclose said workflow process management

application using said report to *automatically* generate subsequent worker assignments

without further interaction with the user. However, Miller et al. does disclose creating

task-level project plans where critical paths and dependencies are defined and

managed within Microsoft Project (col. 6, lines 16-21). Microsoft Project discloses that when task dependencies are created, when a parent task is started early or delayed, the dependent child tasks are automatically changed without further interaction from the user. Thus, once critical paths and task dependencies are identified and inputted into Microsoft Project, any changes to parent tasks automatically generates changes to dependent tasks (i.e., subsequent assignments) without further interaction from the user (see MSProject pages 22-24, 27, 37, 65, 69). Additionally, it was known at the time of the invention that merely providing an automated way to replace a well-known activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Miller et al. to *automatically* generate subsequent worker assignments *without further interaction with the user* as doing so provides a more efficient means of tracking and correcting workflow progress, which ensures that the workflow plan is kept on schedule since feedback from the user is not waited for in order to generate corrections to the workflow plan.

As per claims 2 and 13, Miller et al. discloses the method and apparatus of claims 1 and 12, wherein in said workflow process management application, said user enters a workflow plan by creating relationships between said resource and activity objects for each department (col. 20, lines 9-17; A user may create an organizational structure, which defines the relationships between resources and jobs (i.e., activities).).

As per claims 3 and 14, Miller et al. discloses the method and apparatus of claims 1 and 12, wherein said plurality of activity objects comprise a plurality of fixed activity objects and variable activity objects (col. 6, lines 15-21; col. 8, lines 44-52; Critical paths are defined for project/work plans, where critical paths represent fixed activities. All other activities may be changed, and are thus, variable activities.).

As per claim 4, Miller et al. discloses the method of claim 1, further comprising:

selecting from a group of templates, a selected template and after said selecting, automatically creating a plurality of department, resource, and activity objects associated with said selected template (col. 5, lines 6-19; col. 17, lines 55-67; col. 21, lines 36-43; col. 27, lines 28-40; col. 59, lines 34-53; A user may select from a group of templates such as project, process and training templates. After input is received through the templates, department, resource and task (i.e., activity) objects are automatically created.).

As per claim 5, Miller et al. discloses the method of claim 4, as discussed above. Miller et al. does not expressly disclose the workflow management application being used for a hospital. However, the claimed invention indicating the workflow management application being used for a hospital is mere intended use. That the workflow management application is to be used in a hospital is irrelevant since the intended field of use does not change the overall functionality of the system. The intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Accordingly, at the time of the invention, it would have been obvious to a person

of ordinary skill in the art to use the workflow management application of Miller et al. for

managing the workflow of a hospital because Miller et al. creates workflow processes by

creating objects, where the objects can represent any type of organizational structure

and resource, thus providing a flexible system for managing the workflow of various

types of organizations, including hospitals.

As per claim 6, Miller et al. discloses the method of claim 1, further comprising:

creating, on said computer system, a plurality of objects related to groups,

locations, and acuities, wherein said set of objects further comprises said plurality of

objects related to groups, locations, and acuities (col. 20, lines 4-30; A user may create

objects relating to roles, jobs, teams and organizational structures that identify the

knowledge, skills and attributes relating to those objects as well as the relationship

between those objects.).

As per claim 7, Miller et al. discloses the method of claim 6, wherein in said

workflow process management application, said user enters a workflow plan by creating

relationships between said resource objects, activity objects, and objects related to

groups, locations, and acuities (col. 20, lines 4-30; A user may create objects relating to

roles, jobs, teams and organizational structures that identify the knowledge, skills and

attributes relating to those objects as well as the relationship between those objects.).

As per claims 8-11, Miller et al. discloses a computer readable medium,

comprising similar steps as recited and analyzed above for claims 1-4, 6-7 and 12.

Additionally, Miller et al. discloses that the workflow application builder is web based

(col. 59, line 63-60, line 7; Figure 11B, where users may access the templates remotely via the Internet).

As per claim 22, claim 22 recites limitations already rejected above in claims 1-4, 6-7 and 12. Therefore, claim 22 is rejected on the same basis as claims 1-4, 6-7 and 12.

As per claims 15 and 16, while Miller et al. and MSProject disclose tracking work management processes (Miller et al., col. 6, lines 16-21; MSProject pages 22-24, 27, 37, 65, 69), Miller et al. does not expressly disclose displaying a page in a user interface, said page comprising: a logo region, a menu region, including at least one menu item, a navigation region and a context sensitive area; or wherein the objects created in said creating step are based on user events generated by a user interacting with said menu region, navigation region and context sensitive area. However, MSProject discloses displaying a page in a user interface, said page comprising: a logo region, a menu region, including at least one menu item, a navigation region and a context sensitive area (pages 113-119, last page; MSProject discloses a user interface in which a user interacts with a Windows-based application for managing project data, where the interface includes a logo, menus, navigation regions and context sensitive areas.). At the time of the invention, it would have been obvious to a person of ordinary skill in the art for the work management system of Miller et al. to incorporate typical windows-based features of a logo region, a menu region, including at least one menu item, a navigation region and a context sensitive area as taught by MSProject because

such features are well-known in Windows-based applications and therefore, are familiar
to most users of Windows-based applications, thereby providing a user-friendly
interface that most users already know how to interact with.

As per claim 17, Miller et al. does not expressly disclose the method of claim 15,
wherein said context sensitive area includes a hierarchical control object for showing
and hiding a list of hierarchical objects. MSProject discloses wherein said context
sensitive area includes a hierarchical control object for showing and hiding a list of
hierarchical objects (pages 117-119, last page; Double clicking on various sections of a
page shows a list or view of hierarchical objects.). At the time of the invention, it would
have been obvious to a person of ordinary skill in the art for Miller et al. to include a
hierarchical control object for showing and hiding a list of hierarchical objects because
such a feature provides users with the ability to effectively manage the information that
is displayed to them via the interface by enabling them to see what items they want to
see and hide items they don't wish to see.

As per claim 18, Miller et al. discloses the method of claim 17, wherein said
hierarchical objects comprise at least one department of said organization (col. 5, lines
6-19; col. 6, lines 52-65; col. 20, lines 24-28; col. 27, lines 28-40; col. 59, lines 34-53;
Figure 11A; A user creates resources and tasks (i.e., activities) for a defined
organization through templates. Upon receipt of the resource, task and organizational
structure input, the system then automatically produces a plan for the organization. An
organization may be a department as the disclosure of the instant application defines a
department as an entity that exists to perform a set of core functions.).

As per claim 19, Miller et al. discloses the method of claim 17, wherein said application further permits said user to create a plurality of objects related to groups, locations, and acuities, said set of objects further comprises said plurality of objects related to groups, locations, and acuities, and said hierarchical objects comprise at least one location of said organization (col. 20, lines 4-30; A user may create objects relating to roles, jobs, teams and organizational structures that identify the knowledge, skills and attributes relating to those objects as well as the relationship between those objects.).

As per claim 20, Miller et al. does not expressly disclose the method of claim 15, wherein said menu region comprise at least one of a menu item and a sub-menu. MSProject discloses wherein said menu region comprise at least one of a menu item and a sub-menu (last page). At the time of the invention, it would have been obvious to a person of ordinary skill in the art for the work management system of Miller et al. to incorporate a menu item and a sub-menu in its menu region because such features are well-known in Windows-based applications and therefore, are familiar to most users of Windows-based applications, thereby providing a user-friendly interface that most users already know how to interact with.

(10) Response to Argument

1.   The applicant's arguments have been fully considered but are not persuasive.

2.   The applicant argues on pages 8 and 9 with respect to Claims 1, 8, 12 and 22

that the cited reference of Microsoft Project™ does not teach the generation of

subsequent worker assignments without further interaction from the user. The applicant

further alleges that Project™'s functionality only provides pushing tasks later in time

rather than generating "new" subsequent tasks.

       The examiner respectfully disagrees.

       In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., generating <u>new</u> subsequent tasks) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26

USPQ2d 1057 (Fed. Cir. 1993).

       The rescheduling of task assignments by pushing those tasks to a later time

frame is generating subsequent worker assignments. Since the tasks are rescheduled

at a later point in time, they are subsequent. Also, since the pushing back of these

tasks are in response to a resource shortfall (i.e. from the re-leveling of the resource

loading), this occurs without interaction from the user. Although the applicant argues

that Microsoft does not teach the generating of "new" tasks, this is not what the claim

states. The claim states "generate subsequent worker assignments". The rescheduling

of worker assignments (i.e. tasks in Project™) meets the limitation of those assignments

by being generated subsequently to the original scheduling of those tasks as per the leveling functionality of Microsoft.

The examiner would further very respectfully point out to the applicant that generating a worker assignment from a report is a broad limitation. For example, the CMM invention of Miller provides an assessment (i.e. a report) of an organization's compliance with a maturity model assessment. The maturity model assessment is designed to highlight deficiencies in how the organization is working together as an team. Column 8 line 40-45 notes that corrective actions are undertaken to highlight deficiencies in the maturity level. These corrective actions could also be argued as worker assignments since they involve specific tasks that individuals in the organization take in response to the CMM assessment (i.e. the report). While Miller does not teach generating these assignments automatically, it is noted (as per In Re Venner below) that performing such automatic generation of a manual process does not distinguish over the prior art.

3.   The applicant argues on page 9 with respect to Claim 8 that the cited references do not teach associating resource objects with department objects and a production resource using a skill matrix

The examiner respectfully disagrees.

In column 20 line 24-30, Miller teaches associating resources (i.e. roles) with individuals (i.e. a production resource since the individual is responsible for producing work to get their part of the project done). Furthermore here Miller teaches that the

individual's relationship in the organization (i.e. the department) is defined). Miller teaches in column 59 line 53-60 that the method may be implemented using a computer implemented approach (using modules, i.e. objects).

Furthermore, the examiner would point out that the Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

4.   The applicant argues on page 9 with respect to Claim 12 that the cited references do not teach defining a set of activities that require a minimum skill level.

The examiner respectfully disagrees.

In column 20 line 28-30, Miller teaches that tasks are defined for someone on the basis of their competencies. This implies that tasks have certain minimum competencies in order for an individual to be considered capable of performing that tasks. Similarly in column 6 line 50-55, Miller teaches defining the resource needs of the project. Defining what resources are necessary for the project includes defining minimum competencies for the various tasks in order to ensure that the project can be performed.

Furthermore, the examiner would point out that the Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

5.   The applicant argues on page 10 with respect to the final rejection that the
examiner has failed to provide a prima facie case of obviousness as required by the
Graham factors.

The examiner respectfully disagrees.

The examiner would respectfully point out to the applicant that both Miller and
Microsoft Project™ are analogous art (various places within Miller cite the use of
Microsoft project – see for example, column 6 line 19-21). The examiner has not
ascertained the level of ordinary skill in the art per se, however the cited references
provide ample evidence for what the ordinary level of skill would have been at the time
of the invention.

As to the applicant's assertion that the motivation to combine was inadequate,
the examiner points out that, even assuming arguendo it was, the combination of Miller
and MS Project™ would not result in the destruction of functionality of either Miller or
Project™ in doing so. The fact that Miller explicitly discloses the use of MS Project(TM)
supports this position (see column 6 line 19-21) and furthermore supports the
examiner's position that the combination would result in a predictable result.

Furthermore, in *KSR Int'l Co. v. Teleflex Inc.,* 127 S.Ct. 1727 (2007)., the
Supreme Court emphasized "the need for caution in granting a patent based on the
combination of elements found in the prior art," *id.* At 1739 and discussed
circumstances in which a patent might be determined to be obvious without an explicit
application of the teaching, suggestion, motivation test. In particular, the Supreme Court

emphasized that "the principles laid down in *Graham* reaffirmed the 'functional

approach' of *Hotchkiss,* 11 How. 248." *KSR,* 127 S.Ct. at 1739 (citing *Graham,* 383 U.S.

at 12 (emphasis added)), and reaffirmed principles based on its precedent that "[t]he

combination of familiar elements according to known methods is likely to be obvious

when it does no more than yield predictable results." *Id.*

In support of their argument for the failure to provide a case of obviousness, the

applicant further alleges that since MS Project™ suggests a user check the outcome of

re-leveling or rescheduling tasks that this means that the step is not performed

automatically. However, the fact that a step that is performed automatically and is

subject to inspection or verification later does not mean that the step was not performed

in an automatic way. The claim recites that the subsequent worker tasks are generated

- it says nothing that they can't be checked or verified later.   (If the someone puts their

car through an automatic car wash and checks the outcome later manually, this does

not mean that the actual washing and rinsing of the car was not performed in a

automatic way, only that the washing and rinsing steps were automatically performed).

The examiner considers this argument irrelevant to the claim language of simply

automatically generating subsequent tasks.

6.   The applicant argues on page 5 that the cited references fail to teach where the

template is associated with a hospital and where the department, resource and activity

objects associated with the templates are associated with the departments, resources

and activities of a hospital.

The examiner respectfully disagrees.

The claim language does not result in a functional, structural difference between the cited prior art and a hospital, since it merely states that the template and associated objects are associated with a hospital. (In the final rejection, the examiner noted that the project management teachings of the combined reference would have been obvious to one of ordinary skill in the art for use in a hospital.)

In response to applicant's argument that Miller's teachings of an SEPG fail to teach being associated with a hospital, the examiner points out to the applicant a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

For example, if a claim recites a toolbox in great detail, and another reference shows and describes a toolbox such that this description meets the claim limitations; then the claimed toolbox is not patentably distinct from the reference's toolbox because one toolbox is used in a auto repair shop and the other toolbox is used on the space shuttle. They are both toolboxes and their intended use does not make them patentably distinct. The intended use of one project management method in a hospital does not patentably distinguish over a software engineering process group (SEPG) method when the use does not result in a structural distinction that is claimed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jonathan G. Sterrett/
Examiner
Art Unit 3623

April 8, 2008

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